

REMARKS/ARGUMENTS

Applicant has carefully reviewed and considered the Office Action mailed on September 20, 2004, and the references cited therewith.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1-5, 9, 10, and 13-26 are now pending in this application.

Drawing Objection

The drawings were objected to under 37 C.F.R. 1.83(a). The Examiner stated that the "user interface device for enabling the electronic paper display to present a user with a plurality of reference images grouped for display on the electronic paper display device" must be shown or the feature(s) canceled from the claims(s).

Applicant respectfully traverses the above objection. The Applicant respectfully submits that Figure 1 illustrates a user interface device. In Figure 1, the user interface device is illustrated as reference numeral 120. The language described above is supported in Applicant's specification at page 13, lines 22-25. Applicant respectfully requests that the Examiner withdraw the objection to the drawings.

§102 Rejection of the Claims

Claims 1-4, 9, 10, 13, 16, 18, 19, and 21 were rejected under 35 USC §102(e) as being anticipated by Comiskey, et al. (U.S. Patent No. 6,473,072). Applicant notes that claims 22, 23, and 25 were not expressly rejected, but arguments rejecting the claims were provided. Applicant respectfully requests clarification with respect to the status of those claims in the next correspondence from the Examiner.

Applicant does not admit that the Comiskey reference is prior art and reserves the right to swear behind the same at a later date.

In the office action dated September 20, 2004 the Examiner rejected independent claims 1 and 10. In the rejection, the Examiner asserted that the Comiskey reference describes all the elements and limitations of independent claims 1 and 10. Specifically, the Examiner cited col. 14, lines 47-53 and col.

16, lines 48-68 as describing a “user interface device for enabling a user to select one of a plurality of reference images to be displayed on the electronic paper display device comprising a predefined image which is used to assist the user in drawing a related image over the reference image without having to first draw the reference image.”

The Applicant notes that the above quoted language is not a claim element in either Applicant’s independent claim 1 or independent claim 10. Accordingly, Applicant has addressed the references with respect to the claimed elements, rather than the Examiner’s language.

In addition, the Examiner cited the same portions of the Comiskey reference as describing displaying on the electronic paper display device a plurality of reference images, and enabling a user to select a predefined image from the plurality of reference images for display on the electronic paper display device, where the predefined image assists the user in drawing on the writing surface over the predefined image displayed by the electronic paper display, as recited by Applicant’s independent claim 10.

The Comiskey reference, in one embodiment used by the Examiner, appears to describe an electrostatic printer for providing an underlying image on the drawing surface. (See col. 14, lines 47-49 of the Comiskey reference). In another embodiment used by the Examiner, the Comiskey reference appears to describe downloading and displaying an image on the drawing screen through use of a sliding bar connected to a data source. The Comiskey reference describes a data source as a data storage device or a data communications device such as a pager, a receiver, a modem, an infrared port, or a direct cable connection. (See col. 16, lines 44-59).

In contrast, Applicant’s independent claim 1 recites, besides other things:

A whiteboard apparatus, comprising:
an electronic paper display device;
a writing surface arranged in superimposed relationship
with the electronic paper display device; and
a user interface device for enabling the electronic paper
display to present a user with a plurality of reference images grouped
for display on the electronic paper display device to assist the user in

drawing on the writing surface over a selected one of the plurality of reference images.

The Comiskey reference does not teach a white board apparatus having an electronic paper display device, a writing surface, and a user interface. Rather, the Comiskey reference teaches the interaction between an electronic paper apparatus and a data storage or data communications apparatus.

Additionally, the Examiner uses the statement in the Comiskey reference that its device can download an interactive series of images to argue that the Comiskey reference, therefore, can select one interactive displayed image as the reference image as claimed in Applicant's claim 1. However, regardless of that argument, the Comiskey reference does not appear to teach the claimed features of presenting a user with a plurality of reference images grouped for display on the electronic paper display device and the selection of one for placement on the display device on which a user will draw upon it.

Accordingly, the Applicant respectfully submits that the Comiskey reference does not include each and every element and limitation of independent claim 1. Applicant respectfully requests reconsideration and withdrawal of the §102 rejections for this independent claim, as well as those claims which depend therefrom.

In addition, the Examiner cited the same portions of the Comiskey reference as describing displaying on the electronic paper display device a plurality of reference images, and enabling a user to select a predefined image from the plurality of reference images for display on the electronic paper display device, where the predefined image assists the user in drawing on the writing surface over the predefined image displayed by the electronic paper display, as recited by Applicant's independent claim 10.

As stated above with respect to claim 1, the Comiskey reference does not appear to teach the features of presenting a user with a plurality of reference images grouped for display on the electronic paper display device and the selection of one for placement on the display device on which a user will draw upon it, as are also claimed in claim 10.

Accordingly, the Applicant respectfully submits that the Comiskey reference does not include each and every element and limitation of independent claim 10. Applicant respectfully requests reconsideration and withdrawal of the §102 rejections for this independent claim, as well as those claims which depend therefrom.

§103 Rejection of the Claims

Claims 20 and 24 were rejected under 35 USC §103(a) as being unpatentable over Comiskey, et al. (U.S. Patent No. 6,473,072). Claim 20 is dependent upon claim 1 and, claim 24 is dependent upon claim 10.

For the reasons provided above, Applicant respectfully submits that the Comiskey reference does not teach all the elements and limitations of Applicant's independent claims 1 and 10. Accordingly, since claims 20 and 24 depend from allowable independent claims 1 and 10 respectively, Applicant asserts that claims 20 and 24 are deemed allowable. As such, Applicant respectfully requests reconsideration and withdrawal of the §103 rejection for claims 20 and 24.

Claims 5, 14, and 15 were rejected under 35 USC §103(a) as being unpatentable over Comiskey, et al. (U.S. Patent No. 6,473,072) in view of Chery, et al. (U.S. Patent No. 6,177,927). Claim 5 depends from claim 1, and claims 14 and 15 depend from claim 10.

For the reasons provided above, Applicant respectfully submits that the Comiskey reference does not teach all the elements and limitations of Applicant's independent claims 1 and 10. Accordingly, since claim 5 and claims 14 and 15 depend from allowable independent claims 1 and 10 respectively, Applicant asserts that claims 5, 14 and 15 are deemed allowable. As such, Applicant respectfully requests reconsideration and withdrawal of the §103 rejection for claims 5, 14, and 15.

Claims 17 and 26 were rejected under 35 USC §103(a) as being unpatentable over Comiskey, et al. (U.S. Patent No. 6,473,072) in view of Applicant's admitted prior art (APA, hereafter). Claims 17 and 26 depend from claim 10.

For the reasons provided above, Applicant respectfully submits that the Comiskey reference does not teach all the elements and limitations of Applicant's independent claim 10. Accordingly, since claims 17 and 26 depend from allowable independent claim 10, Applicant asserts that claims 17 and 26 are deemed allowable. As such, Applicant respectfully requests reconsideration and withdrawal of the §103 rejection for claims 17 and 26.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (360) 212-8052 to facilitate prosecution of this matter.

At any time during the pendency of this application, please charge any additional fees or credit overpayment to the Deposit Account No. 08-2025.

CERTIFICATE UNDER 37 CFR §1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: **MS AMENDMENT** Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on this 17th day of December, 2004.

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12/17/04
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